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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/873,522	06/04/2001	Richard E. Scordato	M1005/7006 RJK	3542
26453	7590	11/28/2003	EXAMINER	
BAKER & MCKENZIE 805 THIRD AVENUE NEW YORK, NY 10022			GORDON, BRIAN R	
			ART UNIT	PAPER NUMBER
			1743	11

DATE MAILED: 11/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

AS-11

<b>Office Action Summary</b>	<b>Application No.</b> 09/873,522	<b>Applicant(s)</b> SCORDATO ET AL.	
	<b>Examiner</b> Brian R. Gordon	<b>Art Unit</b> 1743	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 9-16-03.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-8 and 12-77 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 25-29 and 33-37 is/are allowed.
- 6) ☒ Claim(s) 1-5, 12, 13, 15-18, 21-24, 30-32, 38-41, 45, 46, 48-50, 54-61, 65, 66, 68-70 and 74-77 is/are rejected.
- 7) ☒ Claim(s) 6-8, 14, 19, 20, 42-44, 47, 51-53, 62-64, 67 and 71-73 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 16 September 2003 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Drawings***

1. The proposed drawing corrections were received on September 16, 2003. These drawing corrections are approved.

### ***Response to Arguments***

2. Applicant's arguments with respect to claims 1-31 have been considered but are moot in view of the new ground(s) of rejection.

Applicant's arguments filed September 16, 2003 have been fully considered but they are not persuasive. Applicant asserts that the push button of Bilbrey is located on the side of an elongated handle 60. Contrary to applicant, the examiner asserts that the button on the device Bilbrey is located on the top of the handle (see figure 1). In attempt to overcome the disclosure of Bilbrey applicant has amended the claims to recite the body portion (handle) having a ling central axis. The examiner understands that applicant is attempting to point out that the body of the instant device has a vertical axis that is longer than its horizontal axis (as oriented in the figures) while the body of the device of Bilbrey has a horizontal axis longer than its vertical axis (as oriented in the figures). The term "long" is a relative term and has not been defined in the specification or claims to establish a numerical measurement or any other degree for one to determine what how applicant intends to define "long". The examiner asserts that in the

perspective of the user the vertical axis of the handle (body) of the device of Bilbrey may be considered as being "long".

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-5, 12-13, 15-17, 21-24, and 30-32, 38-41, 45-46, 48-50, 54-61, 65-66, 68-70, 74-77 rejected under 35 U.S.C. 102(b) as being anticipated by Bilbrey et al. US 4,475,666.

Bilbrey discloses a servo controlled actuator for an automated liquid dispenser for dispensing reagents or diluting samples with reagent automatically in accord with a programmed local microprocessor or remote computer control.

The instrument includes one or more precision metering syringes 1 arranged for drawing sample by means of probe 2 from a test tube 3, for example, or for dispensing sample or reagent-diluted sample into test tube 3'. The instrument is capable of withdrawing reagent from a reservoir, such as from beaker 4, and then using it to dilute a sample or otherwise to be dispensed from the probe 2.

The particular hand-held probe 2 comprises a handle 60 formed of an elongated bar of tubular or rectangular cross-section material, such as plastic, having a longitudinal circular bore 61 in the embodiment shown. The handle also comprises a push button 73 located on the top surface of the body. A tube holder 62 fits within the

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bore preferably in an interference fit. The tube holder is generally tubular in shape with internal bore 63 and at the one end has a goose-neck configuration with a pair of reverse curves 64, 65. The tube holder 62 ends beyond the goose-neck in a nose portion 66.

As seen in the figures the dispenser tube extends at a downward angle relative to the vertical axis of the handle.

The tube holder 62 carries within it Teflon flexible pipette tubing 67 frequently used in pipetting which communicates with the valve means 6. The tubing 67 trains through the internal bore 63 of holder 62.

The tubing 67 can easily be replaced by pulling it out of the tube holder and inserting another piece of Teflon pipette tubing. The tube holder may be secured within handle 60 by an annular groove 68 around its periphery and a set screw 69 as shown in FIG. 20. This arrangement permits the operator to twist the tube holder within handle 60 to provide any 360 degrees (adjustable angle) orientation for the nose portion 66 as the operator sees fit. The interference fit holds the selected orientation.

The claims appear to be process limitations directed to how applicant intends for the device to be used. The way in which applicant intends for one to use the device does not further structurally limit the device. Factors such as the position (angle) in which the operator holds the device, mounts the tip, pressure exerted on the handle by one's hand by the button or handle, and position of one's hand relative to the angle of the nozzle are all relative to the operator. The operator may choose to hold the device in a number of ways other than what is intended by applicant.

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As to the angle at which the device is held, the operator is allowed to hold the device at any angle to suit his/her personal use or desire. The angle at which the device is held does not limit the use of the device. The device would still function as designed to aspirate and dispense at any angle.

As to the base (stand 41) being stable, the base may be stable depending on how the device is arranged or stored. The base may allow the device to be stable when stored in a particular holder or standing alone.

3. Claims 1-2, 4, 12-13, 15-18, 21-24, and 30-31, 40, 45-46, 48-50, 54-58, 60-61, 65-66, 68-70, 74-77 rejected under 35 U.S.C. 102(b) as being anticipated Chi, Des 221,791

Chi discloses a dispenser that appears to be designed with an actuator button aligned with the central vertical axis of the dispenser. The dispenser also comprises a nozzle that extends from a point on the body of the dispenser and the nozzle appears to be at angle between 60 and 80 degrees relative to the axis. The device also comprises a stable base.

As to the angle at which the device is held or how the device is held, the operator is allowed to hold the device at any angle to suit his/her personal use or desire. The angle at which the device is held does not limit the use of the device.

4. Claims 1-5, 12-13, 15-18, 21-24, and 30-32, 38-41, 45-46, 48-50, 54-61, 65-66, 68-70, 74-77 rejected under 35 U.S.C. 102(b) as being anticipated by Rodgers US 4,475,666.

Rodgers discloses an extinguisher tank 10 provided with a head assembly 11 including an operating lever 12 (actuator button aligned with the central vertical axis) and outlet hose 13 (nozzle that extends from a point on the body and may be adjusted to any desired angle) . As shown, there is provided a cartridge 14 receivable in a bottom exterior entrance opening 15 and cooperating elongated receiving tube 16 extending upwardly into the tank 10. The device also comprises a stable base.

As to the angle at which the device is held or how the device is held, the operator is allowed to hold the device at any angle to suit his/her personal use or desire. The angle at which the device is held does not limit the use of the device.

***Allowable Subject Matter***

5. Claims 25-29, 33-37 are allowed.
6. Claims 6-8, 14, 19-20, 42-44, 47, 51-53, 62-64, 67, and 71-73 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
7. The following is a statement of reasons for the indication of allowable subject matter: The prior art of record does not teach nor fairly suggest a hook extending from a point on said body portion which is sufficiently angularly spaced from the point from which said nozzle extends to permit the hook to fit over a selected portion of the operator's hand when the pipette is being held by the operator in a position for use, an adapter selectively mountable to said body portion, said adapter adjusting the size of

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said body portion to better fit operator hand size, and a padding on at least a portion of said body portion.

### ***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Thompson et al., Arrington, Way, Howard, Huthsing et al., and Iler disclose fluid dispensers.

3. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian R. Gordon whose telephone number is (703) 305-0399. The examiner can normally be reached on M-F, with 2nd and 4th F off.

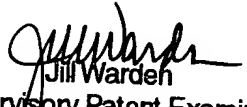


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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 703-308-4037. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

brg  
November 24, 2003

  
Jill Warden  
Supervisory Patent Examiner  
Technology Center 1700